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EXAMINER

KARMIS, STEFANOS

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* JULIAN L. HENLEY

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Appeal 2008-3199  
Application 09/725,142  
Technology Center 3600

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Decided:<sup>1</sup> May 29, 2009

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Before MURRIEL E. CRAWFORD, JOSEPH A. FISCHETTI, and BIBHU  
R. MOHANTY, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

FISCHETTI, dissenting-in-part

DECISION ON APPEAL

STATEMENT OF THE CASE

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

The Appellant seeks our review under 35 U.S.C. § 134 of the final rejection of claims 1-17, 21, 30-35, and 50-60 which are all the pending claims in the application. We have jurisdiction under 35 U.S.C. § 6(b) (2002). Oral arguments were presented on May 21, 2009.

## SUMMARY OF THE DECISION

We AFFIRM-IN-PART.

## THE INVENTION

The Appellant's claimed invention is directed to an online auctioning process for negotiating a price for the performance of personal professional services such as, for example, services performed by a physician on a patient (e.g., as opposed to remotely rendered impersonal services such as the reading of a medical image). (Spec. 4:1-6). Claim 1, reproduced below, is representative of the subject matter of appeal.

1. An online computerized method for arranging scheduled delivery of personal medical services from a provider having verified qualifications, said method comprising:

registering a medical service provider and automatically authenticating qualifications of said medical service provider to perform a proffered medical service upon obtaining registration information from said provider;

posting online at least one proffered personal medical service in association with a provider of such service after having verified the service provider's qualifications for providing such service; and

receiving online bids for such service as proffered by prospective users of such service.

### THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

DiRienzo	US 6,006,191	Dec. 21, 1999
Newman	US 6,035,276	Mar. 7, 2000
Kenna	US 6,108,641	Aug. 22, 2000
Feinberg	US 6,366,891 B1	Apr. 2, 2002
Rackson	US 6,415,270 B1	Jul. 2, 2002
Ilsen	US 6,757,898 B1	Jun. 29, 2004

The following rejections are before us for review:

1. Claims 1-9, 12-17, 21, and 30-35 are rejected under 35 U.S.C. § 103(a) as unpatentable over DiRienzo and Newman.
2. Claims 10-11 and 50-57 are rejected under 35 U.S.C. § 103(a) as unpatentable over DiRienzo, Newman, and Feinberg.
3. Claims 58-60 are rejected under 35 U.S.C. § 103(a) as unpatentable over DiRienzo, Newman, and Rackson.

### THE ISSUE

At issue is whether the Appellant has shown that the Examiner erred in making the aforementioned rejections.

With regards to claims 1-17 and 30-35 this issue turns on whether the prior art discloses automatically authenticating qualifications of a service provider.

With regards to claim 21 this issue turns on whether the prior art discloses forwarding a received online bid to an associated medical service provider together with the information describing the health and/or financial condition of the prospective patient associated with said forwarded bid.

With regards to claims 50-55 this issue turns on whether feedback information is provided which is obtained from a service provider regarding a patient's compliance with medical procedures or the resultant outcome of providing the proffered medical service to the patient.

With regards to claims 56-57 this issue turns on whether feedback information is shown to be provided in the Feinberg reference.

With regards to claims 58-60 this issue turns on whether Rackson discloses or suggests computing an adjusted bid price based on a relative multiplier to a CPT code Relative Value Scale.

#### FINDINGS OF FACT

We find the following enumerated findings of fact (FF) are supported at least by a preponderance of the evidence<sup>2</sup>:

FF1. DiRienzo discloses a method of remote access for a medical image exchange system (Title). The system allows for a diagnostic reading of electronic medical images by physicians where a bid price is used. (Abstract).

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<sup>2</sup> See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

FF2. DiRienzo discloses that each radiologist provides a biography with information such as medical schools attended, publications, affiliations, and residency (Col. 17:12-15).

FF3. DiRienzo does not disclose that all the physicians in the system are Board Certified in their fields since they are only “preferably” Board Certified (Col. 24:2-6) and since all physicians in the system are not eliminated (Col. 30:39-43).

FF4. DiRienzo discloses that each radiologist provides their own biographical information (FF2) but does not disclose automatically authenticating the qualifications of the radiologist.

FF5. DiRienzo does not disclose forwarding a received online bid to a medical service provider with information describing the health or financial condition of the prospective patient.

FF6. Newman discloses a system for generating provider application forms required to be submitted to health care provider organizations by physicians. Physician credentialing profiles are stored in a system database (Abstract).

FF7. Newman discloses that the invention is directed to a system for generating credentialing applications tailored to provider organizations (Col. 2:21-24). The system creates a “universal application form” (Col. 2:46-50) for the physicians.

FF8. Newman discloses that the physicians complete the application form (Col. 3:46-49).

FF9. Newman discloses that the physicians complete the application form (FF8) but does not disclose automatically authenticating the qualifications of the physician.

FF10. Feinberg discloses an online auction system (Title) in which a field 82 stores information including comments from previous buyers who purchased items from the seller (Col. 4:47-51).

FF11. Feinberg does not disclose specific feedback information obtained from a service provider regarding a patient's compliance with medical procedures or the resultant outcome of providing a proffered medical service to the patient.

FF12. Rackson discloses a multiple coordination auction system (Title) in which the bid price may be adjusted (Col. 16:3-24).

FF13. Rackson does not disclose computing an adjusted bid price based on a relative value multiplier based upon a CPT code.

## PRINCIPLES OF LAW

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 550 U.S. at 407 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”) In *KSR*, the Supreme Court emphasized “the need

for caution in granting a patent based on the combination of elements found in the prior art,” *Id.* at 415-16.

## ANALYSIS

### *Claims 1-17 and 30-35*

The Appellant argues that the rejection of claims 1, 30, and 35 is improper because DiRienzo and Newman fail to teach or suggest the automatic *verification* of a service provider’s purported qualification for providing the particular services that are posted (Br. 23). The Appellant argues that claim 1 for example requires *automatically authenticating qualifications* of a service provider which is not shown by the prior art. The Appellant argues that Newman describes only a system for creating and storing “credentialing profiles” of physicians for the purpose of assisting physicians with the completion of forms which are automatically filled-in and generated on of a variety of different possible formats for credentialing application forms (Br. 25, Reply Br. 3-4).

In contrast, the Examiner has determined that the rejection of claims 1, 30, and 35 is proper because a broadest reasonable interpretation of claim 1 for example would merely require that the medical provider be registered in a database, wherein accessing the database to see the list authenticates that the physician is qualified (Ans. 13).

We agree with the Appellant. We first construe the meaning of the limitation in claim 1 requiring “registering a medical service provider and automatically authenticating qualifications of said medical service provider to perform a proffered medical service upon obtaining registration



information from said provider” as used by the appellant in the claims. We determine the scope of the claims in patent applications “not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction ‘in light of the specification as it would be interpreted by one of ordinary skill in the art.’” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed. Cir. 2005) (en banc) (quoting *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004)). The Specification describes that:

The provider's *qualifications* for performing the stated medical services are *authenticated* by means of a search engine 71 having a direct link to a *qualifier database* 72 and/or hyperlinks to one or more other qualifier databases 72.

The term "search engine", as used herein, means an apparatus (or method) automatically operable for receiving a user generated label, searching a directory comprised of one or more databases for a matching label and identifying databases within the directory which contain a matching label. The term "*qualifier database*," as used herein, means an electronically accessible computer-readable storage medium containing authentic certification data for medical service providers. Some examples of qualifier databases include the AMA's membership roster, a State Medical Licensing Board's roster of licensed physicians, the American College of Surgeons roster of board certified surgeons and a roster of Board Certified Plastic and Reconstructive Surgeons, as well as specific hospital staff privileges roster.

*If the medical service provider is qualified to render the medical service being offered, the qualifications are authenticated by the system 16 and the provider-transmitted service and offering price data, including any restrictions (specifications) are accepted by the system 16 as a conditional offer for sale.*

In our view, the claim limitation for “automatically authenticating qualifications of said medical service provider to perform a proffered

medical service” should be interpreted as authenticating qualifications in a qualifier database or some similar medium directly.

Here, DiRienzo merely discloses that each radiologist *provides* their own biographical information but does not disclose *automatically authenticating the qualifications* of the radiologist (FF4). Similarly, Newman merely discloses that the physicians *complete* the application form, but does not disclose *automatically authenticating the qualifications* of the physician (FF9). We note even further that claim 1 requires both “registering a medical service provider” and “automatically authenticating qualifications of said medical service provider.” Having the physician enter their own medical certifications into a database may meet the requirement for “registration” in the claim 1, but such self-reporting of information into a database cannot be fairly considered to be “automatically authenticating qualifications of said medical service provider” when fairly read in light of the specification as it would be considered by one of ordinary skill in the art.

For these reasons the rejection of claim 1 under 35 U.S.C. § 103(a) as unpatentable over DiRienzo and Newman is not sustained. Claims 30 and 35 contain limitations similar to those addressed above and the rejections of these claims is not sustained for the same reasons. The rejection of dependent claims 2-17 and 31-34 which depend from claims 1 and 30 respectively is not sustained for these same reasons as well.

### *Claim 21*

With regard to claim 21 the Appellant argues that DiRienzo and Newman fail to disclose automatically accessing online a data source to obtain information describing the health or financial condition of the

prospective patient and forwarding that information along with a bid for services to an associated health provider (Br. 28, Reply Br. 4-5).

The Examiner has determined that these claim limitations are disclosed by DiRienzo teaching that a physician may access a patient's medical image to be used to develop a diagnosis or treatment (Ans. 16).

We agree with the Appellant. In addition to requiring the access to information describing the health or financial condition of a patient, claim 21 also specifically requires "forwarding a received online bid to an associated medical service provider together with the information describing the health and/or financial condition of the prospective patient associated with said forwarded bid." DiRienzo does not disclose forwarding a received online bid to a medical service provider with information describing the health or financial condition of the prospective patient (FF5) as required by claim 21.

For these reasons the rejection of claim 21 under 35 U.S.C. § 103(a) as unpatentable over DiRienzo and Newman is not sustained.

#### *Claims 50-55*

With regards to claims 50, 52, and 54 the Appellant argues that none of the prior art references show feedback information obtained from a service provider regarding a patients compliance with medical procedures or the resultant outcome of providing the proffered medical service to the patient (Br. 31, Reply Br. 7).

In contrast the Examiner has determined that Feinberg discloses a bidding system in which buyers leave information on sellers (Ans. 20).

We agree with the Appellant. Feinberg does disclose that feedback or comments may be used in the online auction system (FF10). We note that the claims at issue require more than just simple buyer or seller feedback, but rather specific feedback information obtained from a service provider regarding a patient's compliance with medical procedures or the resultant outcome of providing the proffered medical service to the patient. Feinberg does not disclose specific feedback information obtained from a service provider regarding a patient's compliance with medical procedures or the resultant outcome of providing the proffered medical service to the patient (FF11) as required by the claims.

For these reasons the rejection of claim 50, 52, and 54 under 35 U.S.C. § 103(a) as unpatentable over DiRienzo, Newman, and Feinberg is not sustained. The rejection of dependent claims 51, 53, and 55 which depend from these claims is not sustained for these reasons as well.

*Claims 56 and 57*

With regards to claim 56 the Appellant argues that the prior art fails to show “registering at least one medical service provider” and “collecting into a database...feedback information....made available online” as required (Br. 30).

In contrast, the Examiner has determined that Feinberg discloses a bidding system in which buyers leave information on sellers (Ans. 20).

We agree with the Examiner. Claim 56 does not require that any specific type of feedback be left. Feinberg discloses an online auction system which stores information including comments from previous buyers who purchased items from the seller (FF10). The modification of the

systems of DiRienzo and Newman to have a feedback system as disclosed by Feinberg and to extend such a system to both the “buyer” and “seller” is considered an obvious, predictable combination of known elements to have medical bidding system with a single provider form and comments for future bidders on the performance provided by each party.

For these reasons the rejection of claim 56 under 35 U.S.C. § 103(a) as unpatentable over DiRienzo, Newman, and Feinberg is sustained. The Appellant has not argued the rejection of claim 57 separately and the rejection of this claim is sustained for these same reasons.

*Claims 58-60*

With regards to claim 58 the Appellant argues that Rackson fails to disclose computing an adjusted bid price based on a relative multiplier to a CPT code Relative Value Scale (Br. 32, Reply Br. 8).

The Examiner has determined that Rackson teaches computing an adjusted bid price based on certain factors and that CPT codes are well known in the art (Ans. 21).

We agree with the Appellant. Claim 58 requires not only the use of conventionally known CBT codes, but also computing an adjusted bid price based on a relative multiplier to the CPT code Relative Value Scale. Rackson does not disclose computing an adjusted bid price based on a relative value multiplier based upon a CPT code (FF12) as specifically claimed.

For these reasons the rejection of claims 58-60 under 35 U.S.C. § 103(a) as unpatentable over DiRienzo, Newman, and Rackson is not sustained.

#### CONCLUSIONS OF LAW

We conclude that Appellant has shown that the Examiner erred in rejecting claims 1-9, 12-17, 21, and 30-35 under 35 U.S.C. § 103(a) as unpatentable over DiRienzo and Newman.

We conclude that Appellant has shown that the Examiner erred in rejecting claims 10-11 and 50-55 under 35 U.S.C. § 103(a) as unpatentable over DiRienzo, Newman, and Feinberg.

We conclude that Appellant has failed to show that the Examiner erred in rejecting claims 56-57 under 35 U.S.C. § 103(a) as unpatentable over DiRienzo, Newman, and Feinberg.

We conclude that Appellant has shown that the Examiner erred in rejecting claims 58-60 under 35 U.S.C. § 103(a) as unpatentable over DiRienzo, Newman, and Rackson.

#### DECISION

The Examiner's rejection of claims 1-17, 21, 30-35, 50-55, and 58-60 is reversed.

The Examiner's rejection of claims 56-57 is affirmed.

#### AFFIRMED-IN-PART

FISCHETTI, dissenting-in-part

I respectfully dissent with the conclusion arrived at by the majority regarding independent claims 1, 30 and 35.

Based on the description in the Specification on page 20, the majority correctly interprets the limitation in claim 1, *registering a medical service provider and automatically authenticating qualifications of said medical service provider*, to mean “...using a search engine 71 having a direct link to a *qualifier database 72* and/or hyperlinks to one or more other qualifier databases 72.” The definition offered by the Specification for “qualifier database” is “...a storage medium containing authentic certification data for medical service providers.” (Specification 20:20-22).

Newman however similarly discloses using a credentialing managing organization whose job it is to collect physician credential information and load this information into a physician credential information database. (Newman, col.3, l. 46-col.4, l. 5).

Neither the claims nor the Specification require how the credential data gets into the credential database, only that the data be authentic. Given that Newman goes out of its way to provide a credential manager, we should safely infer that one job performed by that person or entity will be to assure the authenticity of the credential being stored. See *KSR Int’l. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007) (In making the obviousness determination one “can take account of the inferences and creative steps that a person of ordinary skill in the art would employ”). Moreover, a credential is a certificate, which by definition, is self-authenticating.

Given that DeRienzo also discloses that each provider has a biography posted on RAMIX and that a user may select/search these biographies for

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“e.g., a highly reputable specialist in the area of concern.” (DeRienzo, col.17, ll. 4-15), hyper-linking or searching for provider by a given medical college attended or by the specialty required would be an obvious expedient in the art. By virtue of a credential managing organization, such as provided by Newman to the RAMIX system in DeRienzo, such a search for a provider listed on the modified RAMIX system would automatically yield an authentic health care provider.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

JRG

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